

Notice of Allowability

Application No.

09/542,109

Examiner

Yogesh C. Garg

Applicant(s)

KIGHT ET AL.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/26/2005.
2. ☒ The allowed claim(s) is/are 36,39,40,42-44,47,48,50-53,55,56 and 58-61.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.


4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 11/21/2005.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
- ☐ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other _____


Yogesh C. Garg
Primary Examiner

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/2005 has been entered.
2. Applicant has amended claims 36, 40, 42, 43, 44, 48, 50, 51, 52, 56, 58, 59, and 60. Claims 1-35, 37-38, 41, 45-46, 49, 54, and 57 are canceled. Currently claims, 36, 39-40, 42-44, 47-48, 50-53, 55-56 and 58-61 are pending for examination.

Drawings

3. The drawings filed on 3/31/2000 are acceptable subject to resubmission of a clean set of drawings. In order to avoid abandonment of this application, resubmission of a clean set of drawings is required in reply to the Office action. The correction will not be held in abeyance.

Allowable Subject Matter

4. Claims 36, 39-40, 42-44, 47-48, 50-53, 55-56 and 58-61 are allowed. Claims 36, 42, 43, 44, 50, 51, 52, 58, 59 and 60 are independent. Claims 39-40, 47-48, 53-56 and 61 are dependencies of claims 36, 44, 52 and 60 respectively.

Reasons for Allowance

5 The following is an examiner's statement of reasons for allowance:

Claims 36, 39, 44, 47, 52-55

The prior art of record before 7/25/1991[Instant application claims priority to this date] neither anticipates nor fairly and reasonably teaches a method, a system and an article of manufacture for processing consumer banking information comprising, inter alia, the steps of storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, receiving a routing number and an account number associated with a financial institution at which a consumer maintains a deposit account, comparing the received routing number to the stored plurality of routing numbers in the financial institutions file for verifying accuracy of the received routing number; wherein the comparing step is performed by a computer and modifying the received routing number or account number to generate a modified routing number or a modified account number (see claims 36, 39, 44, 47, 52-55).

Claims 60

The prior art of record before 7/25/1991[Instant application claims priority to this date] neither anticipates nor fairly and reasonably teaches a method for processing a bill payment request from a consumer via electronic fund transfer method comprising, inter alia, the steps of receiving a request to pay a bill associated with a merchant on behalf of the consumer and a routing number and an account number associated with a financial institution at which the consumer maintains a deposit account, modifying the routing number or account number and determining if the consumer financial institution accepts electronic fund transfers based on the received routing number, and generating an instruction to debit the consumer deposit account by electronic fund transfer if the consumer financial institution is determined to accept electronic fund transfers, in order to process the received pay request; wherein the determining step is performed by a computer (see claim 60).

Claims 40, 42, 43, 48, 50, 51, 56, 58, 59 & 61

The prior art of record before 7/25/1991[Instant application claims priority to this date] neither anticipates nor fairly and reasonably teaches a method, a system and an article of manufacture for processing consumer banking information for a bill payment request from a consumer via electronic fund transfer comprising, inter alia, similar steps

recited in claims 36 and 60, that is comparing the received routing number to the stored plurality of routing numbers in the financial institutions file for verifying accuracy of the received routing number; modifying the received routing number or account number to generate a modified routing number or a modified account number wherein the comparing step is performed by a computer and determining if the financial institution accepts electronic fund transfers based on the routing number (see claims 40, 42, 43, 48, 50, 51, 56, 58, 59 & 61).

Applicant's remarks in the Reply Brief submitted on 1/20/2004 are compelling and commensurate with the original disclosure, see page 2, line 5-page 6, line 21 and page 6, line 9-page 11, line 6 of the Reply Brief which are also consistent with Board's decision, see page 7, line 11-page 10, line 4 of the " Decision on Appeal" mailed on 11/30/2004.

6. Discussion of most relevant prior art:

The following references have been identified as most relevant prior art to the claimed invention(s).

The most closely applicable prior art of record is referred to in Paper 11, Final action mailed on 2/28/2003, that is Braun et al. (US Patent 4,321,672), hereinafter, referred to as Braun in view of Paschal, Jan, " New edition of Rand McNally Bankers

directory available", Journal Record; Oklahoma City; Okla.; Feb 11, 1987, extracted on the Internet from <http://proquest.umi.com> on 01/27/2003, hereinafter, referred to as Paschal. However, Braun in view of Paschal fails to render obvious the application's above-mentioned underlined unique features(s) for claims 36-39, 44, 46, 47, 52-55. See Applicant's arguments on page 2, line 5-page 6, line 21 of the Reply Brief which are also consistent with Board's decision, see page 7, line 11-page 8, line 13 of the "Decision on Appeal" mailed on 11/30/2004, "*Therefore, we find that the examiner has not established a prima facie case of obvious ness of the invention as recited claim 36 and its dependent claims* " .

Another closely applicable prior art of record is referred to in Paper 11, Final action mailed on 2/28/2003, that is Braun/Paschal in view of Lawlor and further in view of Case (US Patent 4,270,042) for claim 60.

However, Braun/Paschal in view of Lawlor and further in view of Case fails to render obvious the application's above-mentioned underlined unique features(s) for claims 40, 42, 43, 48, 50, 51, 56, 58-61. See Applicant's arguments on page 6, line 9-page 11, line 6 of the Reply Brief which are also consistent with Board's decision, see page 8, line 14-page 9, line 19 of the " Decision on Appeal" mailed on 11/30/2004, "*Therefore, additionally we find that the examiner has not made a prima facie case of obviousness of the invention as claimed in independent claim 42 and dependent claim 40* " .

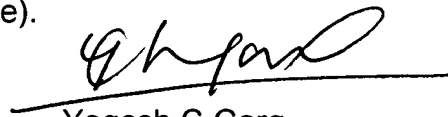
7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
November 21, 2005